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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 200

PETER A. ASSEFF and THE LUBRIZOL CORPORATION,
PETITIONERS

v.

JOHN A. MARZALL, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the United States District Court for the District of Columbia (R. 13) is reported at 86 F. Supp. 419. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 203-205) is not yet officially reported.

JURISDICTION

The judgment of the Court of Appeals was en-

tered on April 26, 1951 (R. 206). The petition for a writ of certiorari was filed on July 24, 1951. The jurisdiction of this Court is presumably invoked under 28 U.S.C. 1254.

QUESTION PRESENTED

Whether petitioners' application for a patent was properly refused for lack of invention over the prior art.

STATUTE INVOLVED

R.S. 4886, as amended, 35 U.S.C. 31, provides as follows:

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

STATEMENT

This is an action under R.S. 4915, as amended, 35 U.S.C. 63,[1] against the Commissioner of Patents by the individual petitioner Asseff (the applicant) and the corporate petitioner, The Lubrizol Corporation (his assignee), to secure the allowance of the Asseff patent application, Serial No. 457,746 filed September 9, 1942, on an alleged invention in a "lubricating composition". The complaint was dismissed by the district court for want of invention over the prior art. The court of appeals affirmed.

1. *Petitioners' application.*—The application describes the alleged invention as one relating to lubricating compositions which are particularly suited for use under high temperature conditions such as those encountered in internal combustion engines of the Diesel types. The base constituent of the composition is a hydrocarbon oil, such as mineral lubricating oil, in which the minor constituent is a compound, the molecular structure of which includes the combination of zinc, the capryl alcohol radical and the dithiophosphate radical. Other compounds may be included in the composition such as detergents, pour point depres-

[1] "Whenever a patent on application is refused by the Board of Appeals * * * the applicant * * * may have remedy by bill in equity, * * * and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. * * *."

sors, and extreme pressure agents to meet particular problems of lubrication (R. 114-128, 13-14). The combination of zinc, the capryl alcohol radical and the dithiophosphate radical is denominated the characterizing agent of petitioners' composition (R. 118), the patentable element in their claims (R. 204), and is defined in all the claims as "the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulfide" (R. 15).

The alleged invention is defined by the claims appearing in the complaint (R. 3-7). Although all the claims are in composition form, they fall into four groups as follows:

1. Claims 1 and 5 (R. 3-4) which call for a single addition agent, the zinc salt of dicapryl dithiophosphate;[2]

2. Claims 9 to 14 inclusive (R. 4-5) and 22 to 24 inclusive (R. 7) which are limited to the use of a second, further, addition agent in the composition, defined broadly as a "detergent of the class consisting of oil-soluble organic compounds containing a metal atom directly attached to an element of the class consisting of oxygen and sulphur" in claims 9, 10, 12 and 13; defined more specifically as "a calcium salt of a petroleum sulphonic acid" in claims 11 and 14, and as an oil-soluble "metallic phenate" in claim 22, which is still more specifically defined as a metallic phenate derived from an ester of "salicylic acid" in claim 23, and as "the mag-

[2] These claims do not form part of the subject matter of the instant petition for a writ of certiorari.

nesium phenate derived from lauryl salicylate" in claim 24;

3. Claims 15 and 16 (R. 5) which also require a second, further, addition agent, defined broadly in claim 16 as an "oil soluble organic corrosion inhibitor," and more specifically as a "halogen bearing organic compound having a vapor pressure less than atmospheric at 140° C." in claim 15; and

4. Claims 17 to 21 inclusive (R. 5-7) which require the presence in the composition of three addition agents, namely the zinc salt of capryl dithiophosphate, the detergent, and the corrosion inhibitor. In these claims, the detergent is defined broadly as in claims 9, 10, 12, and 13, while the corrosion inhibitor is defined broadly in claims 18 and 20, and more specifically, as in claim 15, in claims 17, 19 and 21.

All claims include, as an addition agent, the product obtained by preparing the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulfide, and it is this product upon which petitioners base their contention of patentable novelty in the claims (R. 14).

2. *Prior art.*—On December 8, 1936, a patent, 2,063,629 (R. 190-193) was granted to Salzberg, *et al.* for a compound employed as a corrosion inhibitor in lubricants for bearings which operate under high pressure (R. 192, col. 2, lines 41-43). The patent relates to the production of acid esters and salts of dithiophosphorus acid. Zinc is mentioned as one of the metals forming the salt (R.

192, col. 2, line 19) and the ester portion is provided by aliphatic alcohols containing at least ten carbon atoms (R. 190, col. 1, lines 33-36). (R. 15.)

On July 14, 1942, a patent, 2,289,795 (R. 185-189) was issued to McNab, on an application filed September 1, 1939, for compositions related to improved lubricants for the lubrication of high pressure fuel injection engines such as Diesel engines. The patent discloses the use of a salt of a dithiophosphoric acid ester, especially calcium di-octyl dithiophosphate (R. 187, col. 2, line 70) in conjunction with metal soaps of natural and synthetic fatty acids and naphthenic acid (R. 186, col. 2, lines 56-61). It thus shows the use of a salt of dithiophosphate ester in which the alkyl radical contains eight carbon atoms (R. 187, col. 2, line 70). The McNab patent teaches that viscosity improving agents and pour point depressors may also be included for their particular function (R. 188, col. 2, lines 17-30). (R. 15.)

On April 21, 1942, a patent, 2,280,419 (R. 194-200) was granted to Wilson, on an application filed July 16, 1940, which describes a lubricant containing an oil soluble salt of the so-called "mahogany" sulfonic acids, including the zinc salt, together with oil soluble metal salts of thiophenols (R. 194, col. 1, lines 37-45). The sulfonic acids function as detergents, while the sulfur of the thiophenol imparts anti-corrosive properties (R. 197, col. 1, lines 35-43). (R. 15-16.)

On March 14, 1944, a patent, 2,344,392 (R. 183-184) was granted to Cook *et al.*, on an application filed November 8, 1941, as a continuation in part of a parent application filed July 11, 1941. This patent describes the preparation of heavy metal salts of the dicapryl ester of dithiophosphoric acid, and teaches that such salts are useful as sludge preventers and anti-corrosive agents for lubricating oils used in internal combustion engines (R. 183, col. 1, lines 8-11 and 42-47). Zinc is specifically mentioned as one of the heavy metals (R. 183, col. 1, lines 1-23). The heavy metal salts are stated to cooperate with heavy metal salts of diamyl phenol sulfides described in the Cook *et al.* patent 2,299,626, as well as with alkaline earth metal salts of petroleum sulfonates (R. 183, col. 2, lines 48-53). The dithiophosphoric acid ester salts are described as being good detergents which possess important non-oxidizing or anti-oxidant properties (R. 183, col. 1, lines 43-48), and are usable jointly with other detergents and corrosion inhibitors. (R. 16.)

3. *Proceedings below.*—Petitioners' claims were refused by the Patent Office examiner on the following grounds: (1) Claims 1, 5, and 9-24 were rejected as anticipated by the Cook patent; (2) Claims 9-24 were further rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab; and (3) Claims 16, 18, 20 and 21 were also further rejected as being too broad and indefinite as to the use of the term "corrosion

inhibitor" (R. 142-162). The decision of the examiner was affirmed on all grounds by the Patent Office Board of Appeals (R. 175-176).

Following the refusal of their patent application by the Patent Office, the instant suit was brought under R.S. 4915, 35 U.S.C. 63, against the Commissioner of Patents. After a *de novo* trial, the district court found (1) that petitioners' claims did not antedate the anticipatory effect of the Cook patent, which anticipates all of the claims; and (2) that petitioners' claims 9-24 lack invention and patentability over McNab, Salzberg and Wilson (R. 22). The court found it unnecessary, therefore, to pass upon the issue of petitioners' failure to meet statutory requirements relating to particularity and distinctness (R. 22). It accordingly dismissed the complaint. On appeal, the court below, one judge dissenting, affirmed, similarly holding that the Cook patent anticipated all the claims, and that claims 9-24, even if otherwise patentable, were properly rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab (R. 204-205).

ARGUMENT

It is a basic principle of patent law, applicable to the chemical field as well as to the mechanical, that a patent application which fails to disclose invention over the prior art is not patentable. *Mandel Bros.* v. *Wallace,* 335 U.S. 291; *Dow Chemical Co.* v. *Halliburton Oil Well Cementing*

Co., 324 U.S. 320; cf. *Funk Bros. Seed Co.* v. *Kalo Inoculant Co.*, 333 U.S. 118; see also *General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U.S. 242; *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147. Analysis of the opinions below reveals that no novel question of law is presented which requires resolution by this Court. The issue involved is the factual one of whether, applying this well-settled standard, petitioners' application discloses invention over the prior art. We submit that both courts below correctly held that, on the facts before them, petitioners' application lacks invention. Accordingly further review is not warranted.

Petitioners apparently concede that the Cook patent anticipates all of petitioners' claims as to the use of the zinc salt of the reaction product of capryl alcohol and phosphorus pentasulfide as an addition agent in a lubricant. Petitioners' basic contention here is that claims 9-24 are, nevertheless, patentable as an advance over the prior art by virtue of petitioners' alleged discovery that this specific corrosion inhibitor could be used together with detergents as additives in a lubricating composition (Pet. 9). This position is, we submit, completely belied by the record.

The prior art represented by Wilson (R. 194) and McNab (R. 185) recognized that the use of a plurality of additives in a lubricating oil composition was advantageous and gave improved results. In addition, Wilson recommended that compounds

containing halogen could be used with detergents for improved film strength (R. 199, col. 1, line 1). McNab taught the art the use of metal soaps in conjunction with a salt of dioctyl dithiophosphate far prior to petitioners' application for patent here in suit. Each of these patents teaches the conjoint use of a detergent and a corrosion inhibitor, and, further, McNab indicates that other addition agents, such as thickeners, viscosity index improving agents, and pour point depressors, may be included for their particular function (R. 188, col. 2, lines 17-30).

Salzberg (R. 190) relates specifically to methods for producing acid esters and salt esters of dithiophosphoric acid, and indicates that such compounds act as corrosion inhibitors in lubricants for bearings (R. 192, col. 2, lines 40-43). His disclosed invention embraced the acid esters and their salts such as the alkali, alkaline earth, calcium, zinc, lead and ammonium salts (R. 192, col. 2, lines 17-19).

Accordingly, the prior art was conversant with the use of salts of dialkyl dithiophosphate, and specifically dioctyl dithiophosphate. Since the alcohol used by petitioners in the preparation of the alkyl thiophosphate—capryl alcohol—is admittedly an aliphatic alcohol (R. 90) and an octyl alcohol (R. 88), the use thereof falls clearly within the disclosure of the prior art. The preparation and use of capryl ester was a logical and obvious

adaptation of the teaching of this prior art, requiring for its accomplishment only the skill of the art. Moreover, Salzberg indicated that zinc and calcium salts would be operative as corrosion inhibitors, and McNab substantiates that observation by his specification of calcium dioctyl dithiophosphate in conjunction with other additives for the same purpose. The substitution of the zinc salt for the calcium salt in McNab was well within the skill of the art, and even if improvement resulted, that alone is not the measure of inventive ingenuity. *Sonneborn Sons, Inc.* v. *Coe,* 104 F. 2d 230 (C.A.D.C.); *Rembert et al.* v. *Coe,* 136 F. 2d 793 (C.A.D.C.).

Petitioners argue that it is improper to reject their claims on a combination of these prior art teachings on the ground that the prior art expressly taught that they could not be combined (Pet. 7-9). But even assuming that petitioners' reliance upon the language appearing in the Cook parent application is properly placed (Pet. 7-8), and that the statement quoted really means that a combination of a dithiophosphate and a detergent is ineffective,[3]

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[3] When the statement in the Cook parent application, upon which petitioners rely, is placed in its proper context, the interpretation which petitioners give to it is shown to be without foundation. The Cook parent application discloses the discovery that oil-soluble heavy metal salts of dithiophosphoric acid esters, the basic addition agent of petitioners' claims, possess both detergent and corrosion inhibitor properties. After noting that the addition of small quantities of these salts, either alone or in admixture with other ingredients, to crankcase oil will effectively prevent the deposition of insoluble sludges while also inhibiting to a marked extent the

it is significant that McNab states that the conjoint use of the soap type detergent and thiophenolates gave superior results (R. 187, col. 1, lines 2-12). Since McNab teaches the equivalency of the thiophenolates and the thiophosphates, it would appear evident that the thiophosphates there disclosed would function in the same way. Hence, irrespec-

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oxidation of the oil (R. 165-167), the Cook parent application declares that (R. 167-168):

> It is interesting to compare the results obtained by the incorporation of small amounts of the heavy metal salts of dithiophosphoric acid esters in crankcase oils with the action of mixtures of dissimilar chemicals that have been added to oils in an attempt to accomplish the same purpose. Detergents such as calcium stearate, calcium napthenate and the like have previously been used in admixture with anti-corrosion agents such as triphenyl phosphite and sulfurized sperm oil *that have no detergent properties.* Although each of these two classes of materials will perform its function in a lubricating oil the two separate chemicals do not cooperate to produce a satisfactory anti-corrosion and detergent action when used together. The function of a corrosion inhibitor is to cover the bearings and other corrodable metal surfaces of the automobile engine with a passivating film that prevents corrosion of the metal by the organic acids and other corrosive oxidation products in the oil. On the other hand a sludge inhibitor or detergent, as its name implies, operates to remove adhering solids from the metal parts of the engine and thus to produce a clean metal surface. Consequently, the use of a corrosion inhibitor in admixture with the detergents *heretofore* employed has proven to be ineffective over any extensive period of time, as each chemical tends to offset the action of the other. [Emphasis added.]

In this setting, the language upon which petitioners rely states only that corrosion inhibitors which have no detergent qualities are incompatible with detergents. It plainly does not state that a corrosion inhibitor which does have detergent properties, such as the zinc salt common to the Cook and Asseff claims, is ineffective with detergents. Indeed, the Cook parent application specifically announces that this salt may be used "in admixture with other ingredients." (R. 165).

tive of what Cook may say, the prior teaching of McNab stands out as recommending that the metallic soap type detergent and the calcium salt of a dioctyl dithiophosphate conjointly used in a lubricating composition for Diesel engines would give superior results with respect to corrosion and sludge formation. Petitioners merely followed that teaching and the teaching of Salzberg when they used the zinc salt instead of the calcium salt disclosed by McNab. Following in the path blazed by the prior art, in the manner suggested by the prior art, does not exhibit that degree of creative ingenuity characterized by the term invention. Cf. *Mandel Bros.* v. *Wallace, supra; Asseff* v. *Kingsland,* 178 F. 2d 710 (C.A.D.C.); *In re Asseff,* 36 C.C.P.A. 867, 81 U.S.P.Q. 112.

CONCLUSION

This case involves no issue of significance beyond its particular facts, and the decision below is clearly correct. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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